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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,272	11/04/2003	R. Scott Twomey	5490-000364	5000
27572 7590 01/17/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER APANIUS, MICHAEL	
			ART UNIT	PAPER NUMBER
			3736	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/701,272

Applicant(s)

TWOMEY ET AL.

Examiner

Michael Apanius

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 17-22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed 10/20/2006. The amendments to claims 1, 2, 6, 7, 9, 10, 12, 17, 20 and 21; the cancellation of claims 4 and 5; and the amendment to the specification are acknowledged. Currently, claims 1-3, 6-22, 24 and 25 are pending.

#### ***Claim Objections***

2. Claims 21, 22 and 24 are objected to because of the following informality: at claim 21, line 10, it appears that "the base" lacks proper antecedent basis in the claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) in view of Axelson, Jr. et al. (US 6,558,391).

5. Katz discloses a sizing apparatus for determining the anterior-posterior size of a distal end of a femur, the apparatus comprising: a block (figure 8) having a face (one of 47 in figure 8) engageable with a resected surface of the distal end of the femur, the

block having an upper portion (right 48 as drawn in figure 8) supporting a rod (42) and a lower portion (left 48) having a base, the base being spaced apart from the rod; a body (35, 36) having a lower surface (left portion of 41 as drawn in figure 5) slideably mounted on the base, the body having a portion (41 in figure 5), that surrounds most of the rod, slidably receiving the rod, the body slidably contacting both the rod and the base and moveable relative to the block in a medial-lateral direction; and a stylus (64) mounted on the body.

6. Note that element (48) consists of two legs. One leg is considered the upper portion and the other is considered the lower portion having a base. Note that the body slidably contacts the base when the body is in a far left position (from the perspective of figure 6) relative to the block. The body contacts (near 50 as drawn in figure 5) a lower surface (surface on the right side of element 48 as drawn in figure 5) of the base. In regards to claims 18 and 19, the body of Katz is slidably engaged with a U-shaped channel defined by the base (see U-shape near 45 in figure 5).

7. However, Katz does not expressly disclose that the rod passes through an aperture of the body.

8. It is well-known in the art to provide an aperture on an element through which a rod passes for the purpose of allowing the element to slide on the rod as shown by Axelson (see the aperture in element 22b in figure 5).

9. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted an aperture to mount the body on the rod as is well-known in the art and as shown by Axelson for the portion that surrounds most of

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the rod of Katz because an aperture and a portion that surrounds most of the rod are art-recognized equivalents that equally enable slidable attachment of a body to a rod.

10. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) as modified by of Axelson, Jr. et al. (US 6,558,391), as applied to claims 17-20 above, and further in view of D'Antonio (US 5,810,831).

11. Katz further discloses a U-shaped member (see U-shape around 45 as drawn in figure 5) supporting the rod; a lower portion of the body is slidably received in a U-shaped channel (see around 45 in figure 5) of the base; and modularly connecting a support (300 in figure 34) to the base. Katz further discloses a longitudinal bore (62) coupled to a stylet shaft (63). However, Katz as modified by Axelson does not expressly disclose a stylus shaft moveable in an anterior-posterior direction along the bore. Katz as modified by Axelson also does not expressly disclose a window opening for observing an indicator on a shaft.

12. D'Antonio teaches a stylus (40) that includes a shaft (44) received in a bore (46) of a body, such that the shaft can slide in an anterior-posterior direction and rotate relatively to the bore. The stylus includes an arm (42) and a stylus tip (48). D'Antonio further teaches a window opening (54), an indicator (52) on the shaft, and a scale (58) on the body.

13. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted the stylus and indicator window configuration as taught by D'Antonio for the stylus and indicator configuration of Katz as modified by

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Axelson because the two configurations equally enable measurement of the femur and the configuration used is not critical to the overall apparatus.

14. Claims 21, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) in view of D'Antonio (US 5,810,831).

15. Katz further discloses a method for determining a size of a distal femur, the method comprising: providing a sizing apparatus as noted above; engaging a face (one of 47 in figure 8) of the block to the distal femur; selectively sliding (column 11, line 65 - column 12, line 11) the body along the rod (42) in a medial-lateral direction; sliding a lower surface of the body along an upper surface of the block selectively in the medial-lateral direction; moving (column 12, lines 12-14) the stylus to bring a tip of the stylus in contact with an anterior surface of the distal femur; observing an indicator (81) associated with the movement of the stylus; and reading the size of the distal femur on a scale (80) affixed to the body at a position of the indicator.

16. It is noted that during use of the sizing apparatus, the body may be moved to a far left position. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention, that the lower surface would slide along an upper surface of the base as noted above.

17. Katz does not expressly disclose that the bore (62) extends in an anterior-posterior direction. Katz also does not expressly disclose a window opening for observing an indicator.

18. D'Antonio teaches a stylus extending from an anterior-posterior bore and an indicator configuration with a window opening as noted above.

19. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted the stylus and window indicator configuration as taught by D'Antonio for the stylus and indicator configuration of Katz because the two configurations equally enable measurement of the femur and the configuration is not critical to the overall apparatus.

***Allowable Subject Matter***

20. Claims 11-16 and 25 were previously indicated as allowable.

***Response to Arguments***

21. Applicant's arguments filed 10/20/2006 have been fully considered but they are not persuasive. Applicant argues that the cited art does not disclose the amended claim limitations. In response, it is respectfully submitted that the claim limitations are met under a new interpretation of the prior art as noted above in the rejections.

22. Applicant briefly states disagreement that Katz is combinable with Axelson without the benefit of impermissible hindsight. In response, it is respectfully submitted that Katz is combinable with Axelson as noted above. Axelson is used in the rejection to simply show that it is known within the art to provide an aperture through which a rod may extend. Since it is not critical to the invention whether the rod passes through a

portion that surrounds most of the rod or an aperture, it would have been routine within the art to substitute the alternative elements.

23. Applicant argues that Katz cannot be combined with D'Antonio because Katz requires two scales adjacent to each other on separate portions as shown in figure 21. In response, it is respectfully noted that the embodiment of figure 21 is not relied upon in the above rejections.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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